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7/24/02  
Docket No. 61152-A/JPW/AJM/HA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Saul J. Silverstein et al.  
Serial No. : 09/769,699 Examiner: G. Leffers  
Filed : January 25, 2001 Group Art Unit : 1636  
For : VZV ORF29p PROTEIN-RELATED COMPOSITIONS AND  
METHODS

1185 Avenue of the Americas  
New York, New York 10036  
July 8, 2002.

Assistant Commissioner for Patents  
Washington, D.C. 20231

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RESPONSE TO JUNE 7, 2002 RESTRICTION REQUIREMENT

This Communication is submitted in response to the June 7, 2002 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the June 7, 2002 Office Action was due July 7, 2002. Since July 7, 2002 falls on a Sunday, a response filed on the next business day, i.e., Monday, July 8, 2002, shall be considered timely. Accordingly, this Communication is being timely filed.

In the Office Action, the Examiner restricted pending claims 1-23 under 35 U.S.C. §121 to one of the following allegedly distinct inventions as follows:

- I. Claims 1-7, 9 and 11, drawn to compositions and methods comprising the protein 29p for delivery of a desired compound to a eukaryotic cell;
- II. Claim 8, drawn to a monoclonal antibody that binds the 29p

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protein;

III. Claims 10 and 11, drawn to methods of expressing and secreting a fusion protein;

IV. Claims 12-17, drawn to pharmaceutical compositions and methods of treating or preventing a disorder in an animal; and

V. Claims 18-23, drawn to a nucleic acid complementary to the sequence encoding 29p and methods of use to detect nucleic acids encoding 29p.

In response, applicants hereby elect with traverse Group I, claims 1-7, 9 and 11, for prosecution at this time.

#### REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement set forth in the June 7, 2002 Office Action. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I-V are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of Groups I-V

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are all drawn to VZV ORF29p protein-related methods and compositions. Applicants therefore maintain that Groups I-V are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups II-V would not require a serious burden once the prior art relevant to Group I has been identified.

Therefore, there would be no serious burden on the Examiner to examine Groups I-V together in the subject application. Hence, the Examiner must examine these Groups on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. 101 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

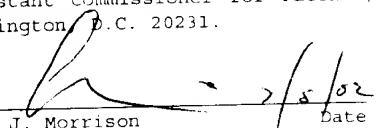
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned

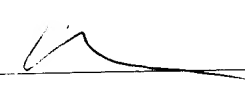
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attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:	
Assistant Commissioner for Patents, Washington, D.C. 20231.	
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